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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/373,230

08/12/1999

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1444 7590 11/07/2008
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EXAMINER

JIANG, DONG

ART UNIT

PAPER NUMBER

1646

MAIL DATE

DELIVERY MODE

11/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

09/373,230

Applicant(s)

OKMURA ET AL.

Examiner

DONG JIANG

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 18, 19 and 24-27.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s): _____.
13. ☐ Other: _____.

/Dong Jiang/
Primary Examiner, Art Unit 1646

Continuation of 3. NOTE: the newly amended claim 24 recites "which can be obtained by ... based on the amino acid sequence of SEQ ID NO:2", however, it does not specify how, structurally, the claimed protein differs from the amino acid sequence of SEQ ID NO:2. It is unclear how to make the changes based on SEQ ID NO:2, for example, where to change and what would be % identity of the claimed variants comparing to SEQ ID NO:2. As such, the amendment raises new issues that would require further consideration, and possible new grounds of rejections under 35 U.S.C. 112. Therefore, the proposed amendment(s) are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

Continuation of 11. does NOT place the application in condition for allowance because:

With respect to the new matter rejection, claims 18, 19, 26 and 27 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record set forth in the previous Office Actions mailed on 2/21/08 and 8/14/08.

Applicants argue, in the response filed on 10/24/08, regarding the limitation "one or two" (claim 26), that while the disclosure of "one or more" does not provide an upper limit, it is clear that "more than one" must necessarily at least be "two" as intended by applicants and as would certainly be recognized and understood by those of ordinary skill in the art (page 6). Applicants argument has been fully considered, but is not persuasive because while "more" (in "one or more") may indicate "at least two", "two" (in "one or two") is not the same as "at least two". They differ in scope, and the specification does not provide sufficient basis for the limitation "one or two".

With respect to lack of written description rejection, claims 18, 19, 24 and 25 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention., for the reasons of record set forth in the previous Office Actions mailed on 8/8/07, 2/21/08 and 8/14/08.

Applicants argue, on page 8 of the response filed on 10/24/08, that at least with regard to "one or two" amino acid modifications recited in claim 26, SEQ ID NO:2 has 157 amino acid residues, thus, a variant of SEQ ID NO:2 that only has a one or two amino acid residue modification is at least 98.7% identical in sequence to SEQ ID NO:2, which situation is analogous to Example 14 in the USPTO's "Synopsis of Application of Written Description Guidelines". Applicants argument has been fully considered, but is not persuasive because it is irrelevant as the issue of "one or two" or claim 26 is not a part of this rejection.